

Application No.: 10/784,794  
Art Unit: 2622

Amendment under 37 C.F.R. §1.111  
Attorney Docket No.: 042229

**AMENDMENTS TO THE DRAWINGS**

Please add new Fig. 12 in accordance with the attached replacement sheet. New Fig. 12 is added to obviate the objection to the drawings. No new matter has been added.

### **REMARKS**

Reconsideration of this application, as presently amended, is respectfully requested. Claims 1-16 and 18-19 and 21-27 are now pending in this application, claim 20 having been cancelled by the present Amendment. Claims 1-12 are allowed. Claims 13-16, 18, 19, 21-24, 26 and 27 stand rejected. Claims 20 and 25 were objected to as being dependent upon a rejected base claim, but were indicated allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Independent claim 16 has been amended to include all of the limitations of claim 20, which depends directly therefrom. Therefore, claim 16 should now be in condition for allowance. Further, independent claim 27 has also been amended to include the features of claim 20. Therefore, claim it is believed that claim 27 should also be in condition for allowance because it includes the features of allowable claim 20. Finally, claim 25 has been rewritten in independent form to include the features of claim 22. Therefore, claim 25 should also be in condition for allowance.

### **Objection to the Drawings**

The drawings were objected to because the feature “printing out received channel setting information by a printer of the communication device,” recited in claim 22, is allegedly not shown in the drawings.

New Fig. 12 has been added by the present Amendment to illustrate “printing out received channel setting information by a printer of the communication device” to obviate the

objection to the drawings. Support for the features found in new Fig. 12 is provided, for example, on page 22, lines 10-16 of the application specification, which describes an embodiment wherein the channel setting information (e.g., a bar code) is transmitted to a facsimile or a personal computer of a user and printed by a *printing means*. No new matter has been added. Approval and entry of new Fig. 12 are earnestly requested.

Further, the specification has been amended to add description of the new figure.

#### **Claim Rejections-35 U.S.C §102**

Claims 13-15 are rejected under 35 U.S.C. §102(e) as being anticipated by **Matsuyama** (USP 7,239,359). For the reasons set forth in detail below, this rejection is respectfully traversed.

As will be discussed in detail below, it is respectfully submitted that there are differences between the invention recited in claims 13-15 and the reference and that the rejection in view of **Matsuyama et al.** does not have merit.

The **Matsuyama et al.** reference is related to a digital broadcasting receiver that performs a channel search operation at a predetermined time (e.g., 4:00 am on Thursday of every week) and, when a new channel is found, channel information related to the new channel is stored in a non-volatile memory. See, e.g., Abstract.

The Office Action asserts that a remote control transmitter 10 corresponds to the claimed “remote controller”; a nonvolatile memory (EEPROM) 14 corresponds to the claimed “rewritable

non-volatile memory”; and considers a CPU 13 to correspond to the claimed “means for judging a channel to be selected.”

Claim 13

First, it is noted that claim 13 recites “a remote control signal for channel selection transmitted *from said remote controller*...wherein the remote control signal for channel selection is a preset code” and “channel setting information transmitted *from a remote controller*...wherein...the channel setting information transmitted from the remote controller is information corresponding to the preset code.” Thus, it is clear that the remote controller recited in claim 13 transmits *both* channel setting information and a remote control signal for channel selection.

The remote controller 10 of **Matsuyama et al.** transmits a remote control light signal for channel selection. However, **Matsuyama et al.** does not teach that the remote controller 10 transmits any signals other than a remote control light signal (see col. 3, lines 22-28). Therefore, **Matsuyama et al.** does not teach that the remote controller 10 transmits “a remote control signal for channel selection [which] ...is a preset code” and “channel setting information ...corresponding to the preset code.” Further, **Matsuyama et al.** does not teach “the channel setting information transmitted from the remote controller is information corresponding to the preset code, and the channel to be selected is judged based on a correspondence between the preset code and the channel setting information.”

Unlike the claimed invention, the “channel information” disclosed by **Matsuyama et al.** is extracted from the digital broadcasting wave (see, e.g., Abstract and col. 4, lines 15-24), and is not transmitted from a remote controller.

Further, it is noted that **Matsuyama et al.** teaches that a user can set the date and time for performing automatic channel search (see col. 3, lines 38-42). **Matsuyama et al.** is silent regarding whether the date and time are entered using the remote controller 10. However, even assuming, *arguendo*, that the date and time are entered via the remote controller 10, the date and time do not correspond to the claimed “information corresponding to a preset code, and the channel to be selected is judged based on a correspondence between the preset code and the channel setting information.”

#### Claim 14

With respect to claim 14, it is respectfully submitted that **Matsuyama et al.** discloses or suggests the claimed “means for setting a channel to be received after release of a stand-by state on the basis of priority channel information included in said channel setting information.”

The Examiner asserts that the “means for setting a channel” corresponds to the CPU 13 of **Matsuyama et al.** However, **Matsuyama et al.** is silent regarding the CPU “setting a channel to be received after release of a stand-by state on the basis of priority channel information included in said channel setting information.”

**Claims 14-16, 18, 19, 21-24, 26 and 27 are rejected under 35 U.S.C §102(b) as being anticipated by Hailey et al. (USP 5,546,193).**

For the reasons set forth in detail below, this rejection is respectfully traversed.

**The Hailey et al reference**

The **Hailey et al.** reference is directed to an autoprogramming feature for a videocassette recorder (VCR) that can locate and program all active channels by mapping only those channels that are active (see Abstract).

**Claim 14**

With respect to independent claim 14, the Examiner asserts that the EEPROM 117 that is part of a VCR corresponds to the claimed “means for storing in a rewritable nonvolatile memory channel setting information transmitted from a remote controller...”. The EEPROM 117 stores autoprogramming channel data, user-entered channel data, and channel mapping data (see col. 3, lines 62-67).

However, **Hailey et al.** does not disclose or suggest the claimed “means for setting a channel to be received after release of a stand-by state on the basis of priority channel information included in said channel setting information.”

The Examiner asserts that the “means for setting a channel” is *inherently* disclosed by the **Hailey et al.** reference. An assertion of inherency means the Examiner recognizes (i.e.,

acknowledges) that the claimed feature is *not* explicitly or implicitly disclosed in the reference, but that the feature would necessarily be present in the reference.

More specifically, regarding inherency, the Manual of Patent Examining Procedure (MPEP) §2112(IV) states the following:

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter *is necessarily present* in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Applicants agree that **Hailey et al.** does not explicitly or implicitly disclose the “means for setting a channel to be received after release of a stand-by state on the basis of priority channel information included in said channel setting information.” However, contrary to the Examiner’s assertion, this feature is not inherently disclosed in the **Hailey et al.** reference, nor has the Examiner shown that this feature is inherent. More specifically, the Examiner has not provided extrinsic evidence that makes clear that the missing descriptive matter is necessarily present in the reference.

Therefore, it is respectfully submitted that the rejection of claim 14 is improper and should be withdrawn.

Claims 16 and 27

With respect to independent claims 16 and 27, these claims have been amended to include the features found in claim 20, which was indicated to recite allowable subject matter. Therefore, claims 16 and 27 should be in condition for allowance.

Further, it is noted that dependent claims 18-19 and 21 were rejected as being *inherently* disclosed by **Hailey et al.** Each of claims 18-19 and 21 (and allowable claim 20) further define the “channel setting information.”

Claims 18-19 and 21 should be allowable by virtue of their dependency on claim 16.

Further, applicants disagree with the Examiner’s assertion that the features recited in claims 19 and 21 are inherent. Furthermore, the Examiner has not met the requirements for establishing inherency, as discussed above.

Claim 22

With respect to claim 22, the Office Action asserts that the remote control unit 125 and IR receiver 122 that receives signals from the remote control unit 125 (see Fig. 1 and col. 3, lines 20-24) correspond to the steps of “transmitting channel setting information to a communication device by communication” and “receiving transmitted channel setting information by the communication device”. Further, the Examiner considers the bar code reader for programming the VCR to correspond to the steps of “printing,” and “reading”. The Examiner considers the step of “storing” to be inherent in the reference.



However, **Hailey et al.** does not disclose or suggest that received channel setting information, which is an IR signal from remote control unit 125 according to the Examiner, is “[printed] out...by a printer of the communication device.” Further, there is no disclosure or suggestion that the bar code sheets disclosed by **Hailey et al.** are “[transmitted]... to a communication device” and “[printed] out ...by a printer of the communication device.”

In other words, **Hailey et al.** discloses no relationship between the remote control unit 125 and the bar code reader that would result in the claimed invention.

Regarding dependent claims 23, 24 and 26, these claims recite the same features recited in claims 18, 19 and 21, respectively. Therefore, the same arguments discussed above with respect to claims 18, 19 and 21 also apply.

In view of the foregoing, it is respectfully submitted that all pending claims patentably distinguish over the cited prior art. Reconsideration and withdrawal of the rejections under §102 are respectfully requested.

### **CONCLUSION**

In view of the foregoing, it is submitted that all pending claims are in condition for allowance. A prompt and favorable reconsideration of the rejection and an indication of allowability of all pending claims are earnestly solicited.

If the Examiner believes that there are issues remaining to be resolved in this application, the Examiner is invited to contact the undersigned attorney at the telephone number indicated below to arrange for an interview to expedite and complete prosecution of this case.

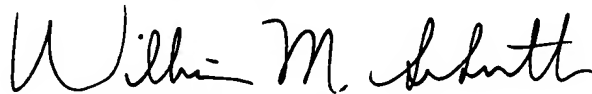
Application No.: 10/784,794  
Art Unit: 2622

Amendment under 37 C.F.R. §1.111  
Attorney Docket No.: 042229

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

**WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP**

A handwritten signature in black ink, appearing to read "William M. Schertler". The signature is fluid and cursive, with the first name "William" being the most prominent part.

William M. Schertler  
Attorney for Applicants  
Registration No. 35,348  
Telephone: (202) 822-1100  
Facsimile: (202) 822-1111

WMS/dlt